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Appl. No. 09/868,289  
Petition of March 31, 2006



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No. : 09/868,289  
Applicants : ARNOUX et al.  
Filed : July 10, 2001  
Title : THERMOSETTING POLY URETHANE/UREA-FORMING  
COMPOSITIONS  
TC/A.U. : 1711  
Examiner: : Sergent, R. A.  
Docket No. : 0244-PC (UNI202US)

MAIL STOP - PETITION  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**PETITION UNDER 37 C.F.R. § 1.181**

Sir:

The above-identified Applicants submit this Petition to the Director pursuant to 37 C.F.R. §§ 1.181 and 1.182. The Applicants seek entry of amendments filed pursuant to 37 C.F.R. § 1.116 on December 19, 2005.

The Applicants are aware that this Petition is being filed more than two months after the Advisory Action of January 4, 2006, and may be dismissed as untimely pursuant to 37 C.F.R. § 1.181(f). However, the Applicants submit that the nature of the action requested in this Petition, particularly in light of the pending appeal in this matter, warrants review by the Director.

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Please charge the official fee of \$400 for filing a petition under 37 C.F.R. § 1.182 to Deposit Account Number 23-2656. A duplicate copy of this page is enclosed.

The Applicants rely on the following facts and arguments to support their position in this petition.

**Introduction**

In an Advisory Action dated January 4, 2006, the Examiner of the above-identified application refused to enter the Applicants' amendments of December 19, 2005, filed under 37 C.F.R. § 1.116. The Applicants submit that the grounds relied upon by the Examiner in refusing to enter the amendments are improper and not in accord with 37 C.F.R. § 1.116 or the MPEP. The Applicants petition the Director for entry of the amendments of December 19, 2005, so that the application will be in condition for allowance or in a better form for consideration on appeal.

**Statement of Facts**

Application No. 09/868,289 was filed on July 10, 2001, as a national phase application of International Application No. PCT/EP99/10040. Claims 1 through 19 were originally filed.

In an Office Action dated July 2, 2002, claims 1 through 19 were rejected under 35 U.S.C. § 112, second paragraph, claims 1 through 3, 7, 10 through 12, and 16 were rejected under 35 U.S.C. § 102(b) as being anticipated by Werner (U.S. Patent No. 3,980,606), claims 1 through 4, 7, 10 through 13, and 16 were rejected under 35 U.S.C. § 102(b) as being anticipated by JP 6-16767, and claims 4 through 9 and 13 through 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Werner or JP 6-16767, each in view of Singh *et*

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*al.* (U.S. Patent No. 5,077,371) and further in view of Rizk *et al.* (U.S. Patent No. 5,817,860) and Gabbard *et al.* (U.S. Patent No. 5,232,956).

In an amendment filed January 2, 2003, Applicants canceled claims 1 through 19 and added new claims 20 through 49.

In an Office Action dated March 18, 2003, claims 21 and 34 were rejected under 35 U.S.C. § 112, second paragraph, claims 20 through 23, 27, 29, 33 through 36, 39, 41 through 43, 45, and 49 were rejected under 35 U.S.C. § 102(b) as being anticipated by JP 6-16767, and claims 20 through 32, 37, 38, 40, 44, and 46 through 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 6-16767, in view of Singh *et al.* and further in view of Rizk *et al.*, Peter (U.S. Patent No. 5,990,258), and Gabbard *et al.*

In an amendment filed September 18, 2003, Applicants amended claims 20, 21, 27, 33, 34, 40, and 42.

In an Office Action dated February 17, 2004, the Examiner made final the rejection of claims 20 through 23, 27, 29, 33 through 36, 39, 41 through 43, 45, and 49 under 35 U.S.C. § 102(b) and the rejection of claims 20 through 32, 37, 38, 40, 44, and 46 through 48 under 35 U.S.C. § 103(a).

In an amendment filed July 16, 2004, under 37 C.F.R. § 1.116, the Applicants amended claims 20, 27, 33, and 42.

In an Advisory Action dated August 13, 2004, the Examiner stated that the Applicants' request for reconsideration had been considered, but did not place the application in condition for allowance. The Examiner did not enter the Applicants' proposed amendments.

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On August 17, 2004, the Applicants filed a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114.

In an Office Action dated September 17, 2004, the Examiner entered the Applicants' submission of July 16, 2004, rejected claims 33 through 49 under 35 U.S.C. § 112, first and second paragraphs, rejected claims 20 through 23, 27, 29, 33 through 36, 39, 41 through 43, 45, and 49 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over JP 6-16767, and rejected claims 20 through 32, 37, 38, 40, 44, and 46 through 48 under 35 U.S.C. § 103(a) as being unpatentable over JP 6-16767, in view of Singh *et al.* and further in view of Rizk *et al.*, Peter, and Gabbard *et al.*

In an amendment filed January 14, 2005, the Applicants canceled claims 27, 29, and 42, amended claims 20 and 33, and added new claim 50.

In a Notice of Non-Compliance of April 20, 2005, the Examiner found the amendment to claim 33 to be non-compliant with 37 C.F.R. § 1.121, because the Applicants failed to underline a change in punctuation. The Examiner also thought a typographical error in claim 40 was an improper amendment.

In a Second Amendment filed May 5, 2005, the Applicants amended claim 33 to denote the change in punctuation, corrected the typographical error in claim 40, and further argued the rejections set forth in the Office Action of September 17, 2004.

In a second Notice of Non-Compliance dated July 27, 2005, the Examiner found the amendments to claims 33 and 40 to be non-compliant with 37 C.F.R. § 1.121, because the Applicants had used single brackets to denote deleted matter rather than double brackets.

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In an amendment filed August 12, 2005, the Applicants amended claims 33 and 40 to replace the single brackets with double brackets.

In an Office Action dated November 2, 2005, the Examiner made final the rejection of claims 33 through 41 and 43 through 50 under 35 U.S.C. § 112, first paragraph, the rejection of claim 49 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over JP 6-16767, the rejection of claims 33 through 36, 39, 41, 43, and 45 under 35 U.S.C. § 103(a) as obvious over JP 6-16767, and the rejection of claims 20 through 26, 28, 30 through 32, 37, 38, 40, 44, 46 through 48, and 50 under 35 U.S.C. § 103(a) as being unpatentable over JP 6-16767, in view of Singh *et al.* and further in view of Rizk *et al.*, Peter, and Gabbard *et al.*

In an amendment filed December 19, 2005, under 37 C.F.R. § 1.116, the Applicants cancelled claims 33, 39, 41, 43, 45, and 49, amended claims 34 through 38, 40, 44, and 46 through 48, and requested reconsideration of the application.

In an Advisory Action dated January 4, 2006, the Examiner stated that the Applicants' request for reconsideration had been considered, but did not place the application in condition for allowance. The Examiner refused to enter any of the Applicants' proposed amendments, including the cancellation of claims 33, 39, 41, 43, 45, and 49.

Applicants filed a Notice of Appeal on January 31, 2006.

**Points to be Reviewed**

In the final Office Action of November 2, 2005, claim 49 was rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as

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obvious over JP 6-16767, and claims 33-36, 39, 41, 43, and 45 were rejected under 35 U.S.C. 103(a) as being obvious over JP 6-16767.

The Applicants cancelled claim 49 in their Amendment of December 19, 2005, under 37 C.F.R. § 1.116. However, the Examiner refused to enter this amendment. Section 714.12 of the MPEP states the following, "*Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 § C.F.R. 1.116(b)(3) is expected in all amendments after final rejection.*" (Emphasis added.)

In this instance, the Applicants were merely canceling a claim. Further, the amendment was made to overcome a new ground of rejection for claim 49 that was first presented in the final Office Action of November 2, 2005. In paragraph 6 of the Office Action of September 17, 2004, the Examiner stated the following:

The examiner has considered applicants' argument that octyldiphenyl phosphate of the reference fails to encompass ethylhexyldiphenyl phosphate. In response to the applicants' argument, the position is taken that applicants have set forth no definitive evidence that the claimed compound is not encompassed by the prior art . . . It is noted that this issue is *not* relevant to claims 33-36, 39, 41, 43, and 49." (Emphasis added.)

Then in paragraphs 4 and 5 of the Office Action of November 2, 2005, the Examiner rejected claim 49 on the same grounds as above after he specifically noted that these grounds did not apply to claim 49.

The response with regard to claim 49 should have been entered because it merely canceled the claim. Further, as shown above, the amendment meets the requirements of 37 § C.F.R. 1.116(b)(3), because the Applicants were responding to a new ground of rejection

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and thus could not have presented it earlier. Finally, the amendment would have placed the application in a better condition for appeal by eliminating the need to appeal the rejection of claim 49 under 35 U.S.C § 102(b) as anticipated by or, in the alternative, under 35 U.S.C § 103(a) as obvious over JP 6-16767.

In the same Amendment under 37 C.F.R. § 1.116, the Applicants also canceled claims 33, 39, 41, 43, and 45, and amended claims 34 through 38, 40, 44, and 46 through 48 to be dependent upon claim 50. The rejection under 35 U.S.C. 103(a), as being obvious over JP 6-16767, had not been applied to claim 50. The Examiner refused to enter these amendments, stating:

The proposed amendment sets forth a combination of limitations not previously claimed. For example, the subject matter of claims 34-36 has not been previously claimed in combination with component (c) as claimed within claim 50. Therefore, the proposed amendment raises new issues that would require further consideration and/or search.

Contrary to the Examiner's claim, these amendments do not raise new issues. It is respectfully submitted that if the cited art was not applicable to independent claim 50, it could not be applicable to claims dependent thereon.

Further, claims 34 through 38, 40, 44, and 46 through 48 were dependent on claim 33. Claim 33 is directed to a process for preparing a polyurethane casting and includes a component (c) that is "a plasticizing agent having a vapor pressure of less than 100 mPa at 25°C and/or an evaporation rate of less than 40% after 24 hours at 87°C according to ASTM 1203-67." Claim 50 is directed towards the same process and includes a component (c) that is "a phosphate ester or phthalate ester having a vapor pressure of less than 100 mPa at 25°C," with specific formulas claimed for both the phosphate and phthalate esters. As

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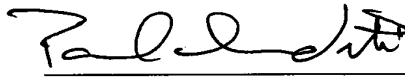
described on page 10 of the specification, the scope of plasticizing agents, as claimed in the present invention, clearly includes phosphate and phthalate esters. Thus, the scope of claim 50 is significantly narrower than the scope of claim 33. Any search done for claims 34-36 as dependent on claim 33 would also include references encompassing claims 34-36 as dependent on claim 50.

**Action Requested**

The Applicants submit that the Examiner improperly refused to enter the amendments of December 19, 2005, submitted under 37 C.F.R. § 1.116. The Applicants request the Director to exercise his or her supervisor authority and have these amendments entered so that the application will be in condition for allowance or in better condition for appeal.

Respectfully submitted,

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Date

  
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